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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,454	04/12/2004	James E. O'Toole	MI40-372	8313
21567	7590	10/04/2005		
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201			EXAMINER HOLLOWAY III, EDWIN C	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,454	Applicant(s) O'TOOLE ET AL.	
	Examiner Edwin C. Holloway, III	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 253-278 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 253-278 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Examiner's Response

1. In response to the application filed 4-12-04 with preliminary amendment, all the amendments to the specification and claims have been entered and the application has been examined. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Specification

2. The abstract of the disclosure is objected to because xxx. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities: The reference to serial number 09502764 in the cross reference to related applications on page 1 of the specification should be updated to identify patent number 6721289.

Appropriate correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed.

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Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 253-278 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6130602 and claim 1-25 of U.S. Patent No. 6721289. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 253-278 of the instant application are generally broader than the claims in applicant's earlier patents. Broader claims in a later application constitute obvious double patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "pork"). In particular, claim 253 of the instant application is nearly identical to claim 1 of the 6721289 patent except that

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claim 253 of the application is broader because claim 253 does not require the limitations "selectable in one second increments" and "in which more power is consumed than in the sleep mode... and a microprocessor-on mode in which more power..." in claim 1 of the 6721289. The remaining claims of the application are similarly broader than corresponding claims in the patents.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 253-256, 268-273 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reis (US 5640151) in view of Rotzoll '512 (5,568,512) or Clarke (US 5,355,513) and further in view of Borrás (US 5,128,938).

The Reis Patent discloses (see at least cols. 12, 35, 39) tags or transponders with intermittent or periodic power supply including a strobe circuit 16 controlling receiver 1 to operated periodically turned off for long period and on only for a short

time period to enable wake-up responsive to received RF commands. Further, the processor or microprocessor 2 is only powered when a valid command signal is received and detected by wake up detect circuit 28 to wake up the processor from a low power mode through an interrupt. The transponder includes an antenna and transmitter, receiver and microprocessor in fig. 3. An example of disable time is the wait timer in col. 35.

Rotzoll '512 discloses an analogous art transponder with a frequency control circuit including a phase lock loop (PLL). Alternatively, the circuit could include a frequency lock loop (FLL) in the lines bridging cols. 4-5. This circuit operates as a variable divider and provides synchronization or calibration to received spread spectrum commands and proper clock or timing for transmitted signals. The arrangement provides an accurate reference frequency and reduced power consumption. The circuit only operates in response to valid commands as stated in col. 6 lines 21-42. The spread spectrum in col. 4 line 35 uses a pseudo noise sequence which at least suggests direct sequence spread spectrum.

Clarke discloses an analogous art transponder with an intermittent powered circuit responsive to an RF wake-up signal and including a PLL operating as a variable divider or timer to provide an accurate reference frequency and reduced power

consumption. See the abstract, fig. 1 and cols. 3-5.

Regarding claims 253-256, 268-273, if it is not clear from Reis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have been obvious to have included in Reis the variable divider FLL or PLL and synchronization or calibration to received spread spectrum commands and proper clock or timing for transmitted signals of Rotzoll '512 or Clarke for providing reference frequency accuracy and increased power conservation and decreased cost by omitting the conventional local oscillator circuit. The FLL is disclosed in analogous art by Rotzoll '512 and is an obvious variation of the PLL in Clarke. Since a PLL includes frequency lock making the FLL obvious. If a single IC is not clear then such will have been obvious because its integration is well known in the art and provides known advantages such as reduced cost and size.

Borras discloses an analogous art communication system with portable transceivers including sleep interval command for setting a particular sleep interval based on prior history for more efficient power conservation. The command selects one of a plurality of predetermined periods for a count down timer. See at least the abstract, col. 5 lines 4-15 and fig. 3.

Regarding claims 253-256, 268-273, if it is not clear from

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the combination applied above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the variable divider of the combination applied above responsive to RF commands signals disclosed in Borrás for more efficient power conservation suggested by the variable dividers in Rotzoll and Clark and the commands resulting in sleep mode control in Reis. Since the FLL of Rotzoll or Clarke replaces the local oscillator for reduced cost, reduced power consumption and increased reliability, the programmable timer of the combination would have been coupled to the output of the FLL in order to receive clock pulses.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mears (US 4525865) discloses a programmable radio.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications.

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Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Prior to July 15, 2005, facsimile submissions may be sent via central fax number (703) 872-9306 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.


Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068.

EH
9/29/05

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